



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,458	07/18/2000	Eiji Hayashi	862.C1958	8847

5514 7590 12/03/2002

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

CHAU, MINH H

ART UNIT	PAPER NUMBER
----------	--------------

2854

15

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,458

Applicant(s)

HAYASHI, EIJI

Examiner

Minh H Chau

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27,28,30,32-36,38 and 40-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27,28,30,32-36,38 and 40-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 32 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language “the display unit” as recited in line 10 of both claims 32 and 40 is inferentially recited.

Claim Objections

3. Claims 32 and 40 are objected to because of the following informalities: There is no antecedent basis for the recitation “the display unit” as recited in line 10 of both claims 32 and 40. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 27-28, 30, 32-36, 38 and 40-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohtani (US # 56,144,818).

With respect to claims 27, 35, 43 and 44, Ohtani teaches a printing control apparatus (2) and a printing control method for controlling a printer (1) having a stapling function (col. 2, line 48 of Ohtani) for binding together a plurality of sheets of printing paper that have been printed out at one of a plurality staplable positions (Fig. 5) and a plurality of paper feed trays (5) (col. 2, lines 41-42), comprising selection means for selecting a particular paper tray (5) from a plurality of paper feed trays (5), a first setting means for setting a desired stapling pattern or binding location such as short-edge stapling position or long-edge stapling position and a limitation means for limiting the staplable position on the basis of the paper feed tray information related to the paper feed tray selected by the selection means and the binding location set by the setting means (see Figs. 1-9 and cols. 2-5 of Ohtani). With respect to the recitation "acquisition means... device information" (lines 3-4 of claim 27, lines 4-5 of both claims 35 and 43, and lines 6-7 of claim 44). Ohtani teaches in col. 3 that the data is being interchanging between the host computer and the printer, which including the information related to the paper feed tray of the printer. In view of this teaching, it is clear to one of ordinary skill in the art that the device of

Ohtani does teaches the acquisition means for acquiring paper feed tray information of the printer in response to the instruction acquiring a device information.

With respect to claim 28 and 36, see cols. 3-4 of Ohtani that teach a desired paper size selection means or a second setting means by the operator, and the limitation means limits the staplable position on the basis of the size of the printing paper set by the setting means and the feed tray selected by the selection means.

With respect to claims 30 and 38, see Figs. 6-9 of Ohtani that shows display means for displaying of a staplable position and an unstaplable position in the screen of the host computer.

With respect to claims 32 and 40, see cols. 3-4 of Ohtani that teach the printing control apparatus is prepared for in a host computer (2) which communicates with a printer by an interactive interface (11), comprising acquisition means for acquires the paper information, which includes selecting or setting direction and size of the printing paper for each paper feed tray prepared for in the printer, from the printer by the interactive interface according to the designation of a user and the limitation means associates paper information acquired by the acquisition means with the paper information of the paper feed tray selected by the selection means according to the instruction of the user from among the list of a plurality of paper feed trays displayed in the display unit and limits the staplable position on the basis of the associated paper information.

With respect to claims 33 and 41, see Figs. 6-10 of Ohtani that shows a display control means for displaying the paper information of a plurality of paper feed trays acquired by the acquisition means and each of the paper information includes setting direction and size of the paper.

With respect to claims 34 and 42, see cols. 3-4 of Ohtani that teach a device list generation means for generating device list information, device selection means for selecting the device corresponding to instruction of the user from among lists based on the generated device list information and the acquisition means is for acquiring paper information for each paper feed tray of the device selected by the selection means.

Response to Arguments

7. Applicant's arguments filed 10/30/02 have been fully considered but they are not persuasive.

With respect to the rejection of claims 27-28, 30, 32-36, 38 and 40-44, the Applicant has argued that "Ohtani does not limit staplable positions based on the paper feed tray information related to the paper feed tray where paper is actually set and the printer which actually executes the staple processing". The Examiner respectfully disagrees with the Applicant's opinion because Ohtani teaches in cols. 3-4 and in Figs. 6-9 that the staple positions is limited based on the paper in each of the feed tray information. Therefore, Ohtani does teaches the limit staplable positions based on the paper feed tray information related to the paper feed tray as explained in the above rejection. The Applicant also argued that "Ohtani is not understood to teach or suggest Applicant's first setting means for setting a binding location", as explained in the above rejection, Ohtani teaches in cols. 3-4 that the operator is selects a desired stapling pattern or setting a binding location such as short-edge stapling pattern or a long-edge stapling pattern, in view of this teaching, it is clear to one of ordinary skill in the art that the selecting of a desired stapling pattern that taught by Ohtani does meets the broad recitation of "first setting means for setting a binding locations" as recited in each of the independent claims.

Art Unit: 2854

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H Chau whose telephone number is (703) 305-0298. The examiner can normally be reached on M - TH from 9:30 AM – 8:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H Hirshfeld can be reached on (703) 305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MHC
December 2, 2002

